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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,292	04/02/2001	Charles M. Link II	BS01-019	8769
28970	7590	03/05/2004	EXAMINER	
			NGUYEN, DUC M	
		ART UNIT		PAPER NUMBER
		2685		
DATE MAILED: 03/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/822,292	LINK ET AL.
	<b>Examiner</b> Duc M. Nguyen	<b>Art Unit</b> 2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 28-39 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION**

This action is in response to the applicant's response filed on 2/24/04.

Claims 1-39 are now pending in the present application.

***Election/Restriction***

1. Applicant's election with traverse of the Restriction requirement in Paper No. 8 is acknowledged. The traversal is on the ground(s) that a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search for the subject matter of the non-elected claims. This is not found persuasive because the claims are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I (claims 1-27) has separate utility such as transmitting update information to a wireless device in response to the detection of a registration event while the invention of Group II (claims 28-39) has separate utility such as the determination of the number of return errors and the determination of the total time.

Because these inventions are distinct for the reasons given above and the search required for Group I would not encompass the search required for Groups II, restriction for examination purposes as indicated is still deemed proper and is therefore made FINAL.

2. Since Applicant has conditionally elected claims 1-27 in Paper No. 8, Group II (claims 28-39) are withdrawn from further consideration by the examiner as being for the nonelected invention. An action for Group I (claims 1-27) follows.

***Information Disclosure Statement***

3. The references listed in the information disclosure statements submitted on 7/15/02 has been considered by the examiner (see attached PTO-1449).

***Claim Objections***

Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 9. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-9, 13-18 are rejected under 35 U.S.C. 102(a) as being anticipated by **Daly** (US Pat No. 6,122,503).

Regarding claim 1, Daly discloses a method for updating the memory (internal database) of a mobile phone via over-the-air programming (OTAP) using SMS messages which would include all the claimed limitations (see col. 3, line 65 - col. 4, line 48), comprising:

- receiving a first information (updates information regarding system operators or service providers) as claimed (see col. 5, line 52 – col. 6, line 9);
- receiving a second information related to registration event (active or inactive) as claimed (see col. 5, line 52 – col. 6, line 9 and col. 10, lines 1-15);
- transmitting a third information (updates information regarding system operator or service providers in SMS format) as claimed (see col. 5, line 52 – col. 6, line 9 and col. 10, lines 1-15);

Regarding claims 2-9, 13, they are rejected for the same reason as set forth in claim 1 above. In addition, Daly further discloses

- converting first information to SMS message (see col. 10, lines 1-15) ;
- comparing second information with a record in a concerned data base (see col. 6, lines 20-63);
- a state of record (pending or waiting indicator (see col. 6, lines 20-63);
- retrieve message for a wait state record (see col. 6, lines 20-63 and col. 10, lines 1-15)
- assembling third information based on characteristics of the wireless device (see col. 6, lines 20-63);

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- third information is an SMS message (see col. 10, lines 1-15) ;
- create an entry in a pending database as claimed (clear indicators, col. 3, lines 61-62);

Regarding claims 14-18, the claims are interpreted and rejected for the same reason as set forth in claims 1-9 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-12, 19, 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly.

Regarding claim 10, the claim is rejected for the same reason as set forth in claim 1 above. In addition, although Daly discloses the registration notice (second information) is sent using IS-41 signaling, it would have been obvious to one skill in the art to modify Daly to use SS7 link in place of IS-41 as well, for utilizing advantages provided by SS7 such as flexibility and cost.

Regarding claim 11, the claim is rejected for the same reason as set forth in claim 1 above. In addition, when the mobile user is roaming in another network and register with the roaming network, it is clear that such registration notice would be fed to the HLR via a signal transfer point (STP) as claimed.

Regarding claims **12, 19**, the claims are rejected for the same reason as set forth in claim 10 above. In addition, in order to receive registration notice, it is clear that a filter would obviously be used in order to filter registration messages from raw SS7 data.

Regarding claims **20-24**, the claims are rejected for the same reason as set forth in claim 1 above. In addition, although Daly fails to disclose the centralized database of the HLR is organized into specific databases as claimed, it would have been obvious to one skill in the art to modify Daly to organize databases into specific databases as claimed, for easy management.

Regarding claims **25, 27**, the claims are rejected for the same reason as set forth in claims 10, 12 above.

Regarding claim **26**, the claim is rejected for the same reason as set forth in claim 11 above.

### Conclusion

**8. Any response to this action should be mailed to:**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to:

703-872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label PROPOSED or  
DRAFT)

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc M. Nguyen whose telephone number is 703-306-4531. The examiner can normally be reached on Monday-Thursday (9:30 AM – 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Duc M. Nguyen  
Mar 4, 2004

